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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,091	01/22/2002	Eiichi Kito	1259-0221P	3458
2292	7590	06/20/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/051,091	<b>Applicant(s)</b> KITO, EIICHI	
	<b>Examiner</b> Matthew S. Gart	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>April 22, 2002</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Prosecution History Summary***

Claims 1-21 are present in this application. Claims 1, 8 and 17 are independent.

***Response to Arguments***

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (U.S. Patent Application Publication 2005/0182649) in view of Quek et al. (U.S. Patent Application Publication 2005/0210413 A1).**

Referring to claim 1. Parulski discloses an order accepting method, said method comprising the steps of:

- Indicating a menu image in a display panel for inputting ordering information to specify an order placed for a service provided by an associate (Parulski: paragraph 0007, "...a service provider providing a menu identifying a plurality of different photo services that can be selected by a user.");
- Determining said order information in response to an input signal according to said menu image (Parulski: paragraph 0008, "...the service provider establishing a user service account containing data identifying a photo service selected by the user from the menu.");
- Wherein said menu image includes:
  - A service-selecting region for selecting one of plural services different from one another (Parulski: "In block **106**, the fulfillment center **40** provides the customer with a menu of photo products **66** that are available

for customization and purchase, such as standard service prints, framed hardcopy prints as depicted in FIG. 3, and customized photo albums as depicted in FIG. 4.”); and

- A conditioning item setting region for retrieving a conditioning application according to said selected service, the conditioning application including a menu of selectable conditioning items and visual controls for setting a selected conditioning item for the common item (Parulski: “In block 110, the network server 42 provides a menu of customizable features for the type of product selected by the user. This menu is displayed on display monitor 14 if the user is located at the home computer system 10, or on touch screen display 84 if the user is located at retail kiosk 80.”)

Parulski does not expressly disclose a menu image comprising plural regions for setting plural items included in said ordering information, said plural regions including at least a common item specifying region for specifying a common item common between said services.

Quek discloses a menu image (Quek: Fig. 2C) comprising plural regions for setting plural items included in said ordering information, said plural regions including at least a common item specifying region for specifying a common item common between said services (Quek: Fig. 2C. “228”).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Parulski to have included the

teachings of Quek as discussed above in order to provide intuitive visual abstractions and mechanisms for efficiently and quickly designating objects, such as digital images to be uploaded to a server (Quek: paragraph 0021).

Referring to claim 2. Parulski further discloses a method wherein said plural services are provided by plural associates (Parulski: Fig. 1B: “**60, 56, 58, 68 and 64**”).

Referring to claim 3. Parulski further discloses a method wherein said plural services are printing services for printing an image (Parulski: Fig. 1B: “**58**”).

Referring to claim 4. Parulski further discloses a method wherein said ordering information is sent to one of said associates through a communication line, and said one associate is combined with a selected one of said plural services according to said ordering information (Parulski: paragraph 0002).

Referring to claim 5. Parulski further discloses a method wherein said conditioning item setting region is preset individually between said plural associates (Parulski: Fig. 1B: “**60, 56, 58, 68 and 64**”).

Referring to claim 6. Parulski further discloses a method wherein said conditioning item includes information of a product type of a product according to said service, layout information of said image in said product, and/or information of an

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amount and/or cost of said product, and wherein said layout information includes information of a size of said product, disposition of said image, and/or a size of said image (Parulski: Fig. 5).

Referring to claim 7. Parulski further discloses a method wherein said plural services include at least one of a service of developing photo film and printing said image, a reprinting service of said image, a printing service according to a template layout of plural images (Parulski: Fig. 1A: “**132, 134 and 136**”), an enlarging printing service of said image, a producing service of a booklet of plural images, a printing service of said image to a sheet, and a printing service of said image to an article (Parulski: Fig. 5).

Referring to claims 8-16. Claims 8-16 are rejected under the same rationale as set forth above in claims 1-7.

The Examiner notes (with reference to claim 14), neither Parulski nor Quek expressly disclose an order accepting apparatus as defined in claim 11, wherein said service selecting region and said conditioning item setting region are arranged horizontally to one another.

The Examiner notes, shifting the menu regions does not modify the operation of Parulski's invention. To have modified Parulski to have included various menu region arrangements would have been obvious to the skilled artisan because the inclusion of

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such step would have been an obvious matter of design choice in light of the method already disclosed by Parulski. Such modification would not have otherwise affected Parulski and would have merely represented one of numerous steps that the skilled artisan would have found obvious for the purposes already disclosed by Parulski.

Additionally, applicant has not persuasively demonstrated the criticality of providing this arrangement versus the arrangement disclosed in Parulski. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

The Examiner notes (with reference to claim 15), Quak discloses an order accepting apparatus wherein said common item specifying region (Quak: Fig. 2C, "228") is disposed under at least one of said other setting regions (Quak: Fig. 2C, "224" and "226").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Parulski to have included the teachings of Quak as discussed above in order to provide intuitive visual abstractions and mechanisms for efficiently and quickly designating objects, such as digital images to be uploaded to a server (Quak: paragraph 0021).

Referring to claims 17-21. Claims 17-21 are rejected under the same rationale as set forth above in claims 1-7.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG  
Primary Examiner  
June 15, 2006